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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/679,833	10/06/2003	Bret A. Ferree	BAF-15302/29	3712
7590	10/05/2004			
John G. Posa Gifford, Krass, Groh, Sprinkle, Anderson & Citkowski, P.C. 280 N. Old Woodward Ave., Suite 400 Birmingham, MI 48009-5394			EXAMINER COMSTOCK, DAVID C	
			ART UNIT 3732	PAPER NUMBER

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/679,833

Applicant(s)

FERREE, BRET A.

Examiner

David Comstock

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 01/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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## **DETAILED ACTION**

### ***Claim Objections***

Claim 5 is objected to because of the following informalities: line 2, the second instance of "first" should be changed to --second--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 5, the phrase "or other" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or other"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 7 and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Epstein et al. (5,556,434; cited by Applicant).

Epstein et al. disclose a prosthesis 10 comprising first and second prosthetic components, i.e. the acetabular component 14,16 and the stem component 60 (see Figs. 1 and 3). A plurality of roller bearings 32,34,46,56,58 are situated between the two prosthetic components to reduce friction. The components are tethered to each other, i.e. fastened or restricted by their mechanical relationship. The prosthesis allows rotation about two orthogonal planes defined by the axes extending vertically through the member 30 and horizontally through the member 56 (as seen in Fig. 1). The stem 60 of the prosthesis can rotate about one of the planes, relative to the remainder of the prosthesis.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Albrektsson et al. (5,443,516).

Albrektsson et al. disclose a joint prosthesis comprising first and second prosthetic components 1aa,2aa and a plurality of roller elements 32aa' in a roller bearing between the prosthetic components (see Fig. 2). The prosthetic components are capable of being used on both small joints, e.g. fingers and knuckles, as well as large joints such as the components of the knee (see col. 1, lines 10-13). The components include a recess, e.g. 11aa or 22aa, for receiving the rollers. The bearing is sealed, at least somewhat, by the walls of the bracket 22aa. The prosthetic components are tethered to each other, i.e. fastened or restricted, by the fasteners 42aa, the brackets 11aa and 22aa, and their mechanical relationship.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epstein et al. (5,556,434; cited by Applicant).

Epstein et al. disclose the claimed invention except for a seal on the bearings. Open bearings and sealed bearings were well-known equivalents in the mechanical arts at the time of the invention. Therefore, a person of ordinary skill in the art would have found it obvious to substitute sealed bearings for open bearings, as this would merely be the substitution of functionally equivalent bearing types.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Epstein et al. (5,556,434; cited by Applicant) in view of Nassar (5,389,107).

Epstein et al. disclose the claimed invention except for the shock absorber. Nassar discloses a prosthetic joint 10 having a shock absorber 34 in order to cushion compressive forces applied between the femur and the pelvic bones and increase the safety and comfort of the device for the user (see, e.g., Fig. 1; Abstract; and col. 1, lines 44-59). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the prosthesis of Epstein et al. with a shock absorber, in view of Nassar, in order to cushion compressive forces applied between the femur and the pelvic bones and increase the safety and comfort of the device for the user.

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***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Comstock whose telephone number is (703) 308-8514.



D. Comstock  
01 October 2004



KEVIN SHAVER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700